REMARKS

I. Introduction

The application has been carefully reviewed in light of the Office Action dated April 19, 2002. This communication is believed to be a full and complete response to that Office Action. Claims 1-7 were pending in the present application prior to entry of the present amendments. By the present Office Action claims 1-7 have been rejected.

By the present amendment, claim 1 has been amended. Claims 2, 6, and 7 have been canceled without prejudice. Upon entry of the present amendment, claims 1, and 3-5 are present.

Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications.

Because the present amendments (1) do not raise new issues requiring further consideration or search, (2) do not introduce new matter, (3) materially reduce the issues for appeal, and (4) place this application into better condition for allowance, entry is appropriate under 37 C.F.R. § 1.116, and is respectfully requested.

I. SUMMARY OF THE AMENDMENTS

In the Claims

Claim 1 has been amended. Claims 2, 6, and 7 have been canceled.

II. CLAIM REJECTIONS

Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 2, and 4-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,241,806 to Ziegler *et al.* ("***Ziegler***") in view of U.S. Patent No. 5,775,067 to Hawley ("***Hawley***"). Office Action at ¶ 1.

Applicant has amended independent Claim 1 to overcome this rejection, which is therefore believed to be moot.

More specifically, independent Claim 1 has been amended to recite, *inter alia*, "said second linear speed is selectively variable with respect to said third linear speed." It is clear that neither ***Hawley*** nor ***Ziegler*** recites this limitation, particularly as ***Hawley*** includes absolutely no teaching or suggestion of a third grouping conveyor operating at a third linear speed, and as the Office Action acknowledges, "the ability to vary the speed of the metering conveyor is still within the scope of Ziegler et al **as long as the speed of the grouping conveyor is varied the same as the metering conveyor.**"

It is settled that to establish *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. *See e.g., In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). *See also* MPEP § 2142.

Because no combination of the prior art references cited teaches or suggests all the claim limitations of amended Claim 1, as demonstrated above, the claim is patentable over those references. Furthermore, as to Claim 3, neither cited reference teaches or suggests said second linear speed [of said metering conveyor] is less than said third linear speed [of said grouping conveyor] at least because neither reference contemplates disparate relative speeds of the second and third conveyors at all.

Moreover, Claims 3-5 depend from independent Claim 1, and are patentable for the aforementioned reasons, as well as on their own merits. Claims 2, 6, and 7 have been canceled, rendering the rejections thereto moot.

Under 35 U.S.C. § 112

The Examiner has rejected claims 1-7 under 35 U.S.C. § 112, stating that the claims are incomplete because the means forming the lanes must be claimed. Office Action at ¶ 2. This rejection is respectfully traversed. The Office Action does not specify which paragraph of the statute is applied, although the rejection is in appropriate whether made under the first or the second paragraph § 112.

Assuming the Examiner deems the means for forming the lanes to be unclaimed essential matter (§112, paragraph 1) the rejection is traversed on grounds that the absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 35 U.S.C. 112, ¶ 1, for lack of adequate written description. *See* Interim Guidelines for the Examination of Patent Applications; 3-7 Chisum on Patents § 7.04. Those skilled in the relevant art, that is, packaging machines in particular and conveying systems in general, will readily appreciate suitable means for forming a lane.

Similarly, the Office Action can find no support for its rejection in the second paragraph of § 112, because one of ordinary skill in the art would be placed on notice by the phrase "article lane". In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See, e.g.*, *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished). MPEP § 2173.02.

Furthermore, those skilled in the art would recognize that means for forming lanes is an inherent feature, so it follows that specifically claiming said feature is unnecessary. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the

reference, and that it would be so recognized by persons of ordinary skill." MPEP § 2163.07(a).

Claim 3 has also been individually rejected under 35 U.S.C. § 112. The Examiner states that:

> *Claim 3 is based on an inadequate disclosure because having the speed of the metering conveyor less than the speed of the grouping conveyor which itself is less than the speed of the infeed conveyor will not cause the articles between selected lugs 432 on the metering conveyor to disappear as they move further downstream and onto the grouping conveyor. Since there is no chance for the excess articles to delay in the lanes for the formation of the next group and there is no disclosure of them being dropped or diverted to another location, they can either be crushed between the relatively moving lugs 432 and 452 or disappear by magic. Unfortunately, neither of the last two options have been disclosed either.*

Id. at ¶ 2. We respectfully traverse.

The Office Action contends that the articles between selected lugs 432 must disappear, be dropped, be diverted, or be crushed if the speed of the metering conveyor is less than the speed of the grouper conveyor, which is less than the speed of the infeed conveyor. Those skilled in the art would appreciate, and indeed, the disclosure of ***Ziegler*** discusses, the purpose and effect of having the infeed conveyor speed greater than the speed of the metering conveyor. The instant application introduces the concept of variably adjusting the speed of the metering conveyor relative to that of the grouping conveyor. More specifically, as long as the metering conveyor speed does not exceed the grouping conveyor speed, the lugs on the respective conveyors are properly aligned and spaced, and the relative speeds are dictated by the desired array size, none of the outcomes described by the Examiner are prescribed.

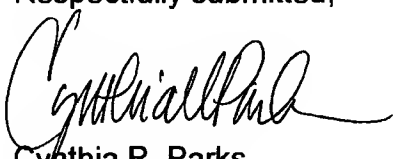
To illustrate the adequacy of the disclosure, a time lapsed series of images has been attached to this Response, the images showing a configuration as described in the Applicant's specification, with the metering conveyor 430 operating at speed that is less than the speed of the grouping conveyor 450. Both conveyors are traveling from left to right across the page. This speed differential becomes obvious as one views the images in sequence, in that the leading grouper lug 452a eventually overtakes the leading metering lug 432a. The desired array that will be disposed between the grouper lugs 452a, 452b includes the four articles labeled as A1' and A2'. The remaining articles labeled as A1" and A2" would be grouped between grouper lug 452b and the following grouper lug (not shown). Clearly, the speed differential allows reduction of the number of articles that define the width and depth of the array, although it can be appreciated that if the speeds matched, and additional two articles would have time to be conveyed into the same space.

As an example, the relationships between the various parameters inherent to operation of the invention as described in the specification can be represented as follows. Assuming each article has a diameter D, the width of an array of articles is W (which is an even integer that is approximately equal to multiple by D, and the group interval has a pitch P, the second linear speed can be representative as $\frac{W}{P}$ but cannot exceed the third linear speed.

III. CONCLUSION

For at least the above reasons, Applicant respectfully requests allowance of the claims pending in this case and issuance of a patent containing these claims in due course. Should the Examiner believe that a telephone conference would be useful to resolve any concerns and move this application to allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below. Otherwise, Applicant respectfully requests timely issuance of a Notice of Allowance for the present application.

Respectfully submitted,



Cynthia R. Parks
Reg. No. 52,096

Date: May 26, 2006
PARKS KNOWLTON LLC
1117 Perimeter Center West, Suite W307
Atlanta, Georgia 30338
(678) 325-6602
Docket No: D-3032-1

Enclosure (3 pages of color images)